

REMARKS

The Office Action dated December 30, 2008, has been received and carefully noted. The above amendments to the claims, and the following remarks, are submitted as a full and complete response thereto.

Claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 are currently pending in the application, of which claims 1, 19, 45, 60, 65-66, and 70 are independent. Claims 19 and 66 have been amended to more particularly point out and distinctly claim the invention. No new matter has been added. Claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 are respectfully submitted for consideration.

The Office Action rejected claims 1-2, 5-9, 11-20, 23-27, 29-34, 36, 45-46, 49-53, 55-66, and 70 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over U.S. Publication No. 2003/0193967 of Fenton, *et al.* ("Fenton") in view of U.S. Patent No. 6,871,065 of Yamaguchi ("Yamaguchi"). The Office Action acknowledged that Fenton fails to disclose or suggest all the features of the rejected claims, and consequently the Office Action cited Yamaguchi to remedy the deficiencies of Fenton. Applicants respectfully traverse this rejection.

Claim 1, upon which claims 2-3 and 5-18 depend, is directed to a system including a first system entity configured to provide a multimedia messaging service to a user equipment connected to a network of a system. The system also includes a second system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service. The first system entity is configured to send a

message to the second system entity. The message includes roaming information about the user equipment. The second system entity is configured to use the roaming information when providing the value added service to the user equipment.

Claim 19, upon which claims 20-21, 23-34, 36, and 61-62 depend, is directed to a method including receiving, by a device, a message including roaming information about a user equipment from a network entity providing a multimedia messaging service. The method also includes providing, by the device, a value added service to a user of the user equipment via the multimedia messaging service using the received roaming information.

Claim 45, upon which claims 46-47, 49-59, and 63-64 depend, is directed to an apparatus including a receiver configured to receive a message from a network entity providing a multimedia messaging service. The message includes roaming information about a user equipment. The apparatus is configured to provide a value added service to a user of the user equipment via the multimedia messaging service using the received roaming information.

Claim 60 is directed to a computer-readable storage medium including a computer program set, wherein the execution of the program set in a computer causes the computer to execute a process. The process includes receiving a message from a network entity providing a multimedia messaging service, wherein the message includes roaming information about a user equipment. The process also includes providing a value added service to a user of the user equipment via the multimedia messaging service using the roaming information.

Claim 65 is directed to a system including a first system entity means for providing multimedia messaging service to a user equipment connected to a network of the system. The system also includes a second system entity means for providing a value added service to a user of the user equipment via the multimedia messaging service. The system further includes sending means for sending a message from the first system entity means to the second system entity means, wherein the message includes roaming information about user equipment. The second system entity means is configured to use the roaming information when providing the value added service to the user equipment.

Claim 66 is directed to a method including providing, by a first system entity, a multimedia messaging service to user equipment connected to a network of a system. The method also includes providing, by a second system entity, a value added service to a user of the user equipment via the multimedia messaging service. The method further includes sending a message from the first system entity to the second system entity, wherein the message includes roaming information about the user equipment. The method additionally includes using, by the second system entity, the roaming information when providing the value added service to the user equipment.

Claim 70 is directed to an apparatus including receiving means for receiving a message from a network entity providing a multimedia messaging service, wherein the message includes roaming information about a user equipment. The apparatus also includes providing means for providing a value added service to a user of the user equipment via the multimedia messaging service using the received roaming information.

Applicants respectfully submit that the combination of Fenton and Yamaguchi fails to disclose or suggest all of the elements of any of the presently pending claims.

Fenton discusses a method, apparatus and system for processing multimedia messages. Fenton fails to teach, for example, the following features of independent claim 1: “wherein the first system entity is configured to send a message to the second system entity, wherein the message comprises roaming information about the user equipment.”

As to the above features it should be first noted that the “first system entity” as claimed is “configured to provide a multimedia messaging service to a user equipment connected to a network of a system.” Thus, in Fenton, such first system entity seems to be (in the best interpretation for the Office Action’s position) the Multimedia Messaging Center (MMC) 126. Secondly, the “second system entity” as claimed is “configured to provide a value added service to a user of the user equipment via the multimedia messaging service.” In Fenton, such second system entity seems to be (in the best interpretation for the Office Action’s position) the MMS value added service (VAS) application 136. However, Fenton does not seem to show or suggest in any way that the MMC 126 would send a message comprising roaming information about the user equipment to the MMS VAS application 136. Consequently, Fenton clearly fails to disclose the above claim feature.

In this regard, the Office Action referred to paragraphs [0039] and [0133] of Fenton. However, these portions of Fenton also seem to be completely silent about the MMC 126 (or any other system entity configured to provide a multimedia messaging

service to a user equipment connected to a network of a system) being configured to send a message comprising roaming information about the user equipment to the MMS VAS application 136 (or any other system entity configured to provide a value added service to a user of the user equipment via the multimedia messaging service).

In fact, paragraph [0039] of Fenton merely mentions that roaming conditions can be used as a charging mechanism. Moreover, paragraph [0133] of Fenton merely suggests that customized message processing instructions may be used (see Fig. 12) within the MMC whereby it is possible to instruct the MMC not to deliver a multimedia message to a destination device whenever the destination device is roaming. However, as already noted above, neither of these passages in any way suggests that the first system entity is configured to send a message to the second system entity, wherein the message comprises roaming information about the user equipment.

It is further noted that the term “roaming” does not seem to be even mentioned anywhere else in the description of Fenton. Also Fenton seems to be completely silent about sending any messages, whatsoever, comprising any roaming information.

Fenton further fails to teach the following feature of independent claim 1: “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment.”

The Office Action has admitted that Fenton fails to disclose this last element of claim 1, but has again cited Yamaguchi as allegedly disclosing this claim element. Yamaguchi does not remedy any of the above-identified deficiencies of Fenton.

Yamaguchi discusses a mobile communication system, method and program. However, also Yamaguchi fails to disclose the feature “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment” for the following reasons:

Firstly, it should be noted that the pending claims define that the second system entity is configured to provide a value added service to a user of the user equipment via the multimedia messaging service. However, Yamaguchi is completely silent about any such system entity which is configured to provide a value added service to a user of the user equipment via the multimedia messaging service. In fact, Yamaguchi does not seem to even mention *e.g.* the multimedia messaging service. Therefore none of the system entities of Yamaguchi correspond to the claimed “second system entity” and, consequently, when properly considering all the limitations of the claim, Yamaguchi cannot disclose the feature “wherein the second system entity is configured to use the roaming information when providing the value added service to the user equipment.”

The Office Action referred to column 8, lines 60-65, of Yamaguchi which reads:

Then, when roaming information as information necessary to keep already provided content services is obtained from the GW unit which responds, it is kept to provide content services from the content server 24 that is an access request destination via the second GW unit 232 using the roaming information.

In other words, the cited portion of Yamaguchi relates to a situation in which a mobile user terminal is connected to a GW (GateWay) unit via a mobile communication network which is a cellular telephone network. The GW unit is connected to the Internet,

thereby providing a connection to the mobile terminal to the Internet. In this arrangement, all communication from the Internet to the mobile terminal and from the mobile terminal to the Internet goes thru the GW. For example, the GW unit executes the protocol conversion and the like and transmits the designated content data via the mobile communication network to the mobile user terminal.

Assume, for the sake of illustration, that the mobile user terminal in Yamaguchi issues an access request to a content server in a first area in the mobile communication network. When the mobile user terminal moves from the first area to a second area, the mobile user terminal would be now connected to a radio communication base station which manages the second area in the mobile communication network. This is achieved by the execution of the roaming service. Roaming information – as communication information necessary for communication with the content server – is transferred from the radio communication base station managing the first area to the radio communication base station managing the second area. Therefore, it is possible for the mobile user terminal to keep the communication connection with the content server via the GW unit by the execution of the roaming service.

As one would note, the roaming information is transferred from one base station to another base station. In Yamaguchi, base stations provide necessary links for communication between a mobile terminal and the mobile communication network but they are not using the roaming information when providing a value-added service.

The roaming information is necessary to keep the communication connection alive. In addition, Yamaguchi does not seem to show or suggest that the content server 24 would use the roaming information in any way.

As a result of the above, it is clear that Yamaguchi firstly fails to disclose any system entity corresponding to the second system entity as claimed, and secondly, Yamaguchi fails to disclose the use of the roaming information when providing the value added service to the user equipment by such second system entity as claimed.

As to the motivation to combine the alleged teaching of Yamaguchi into the system of Fenton the Office Action suggested that such motivation would be “to provide the mobile communication system suitable to provide contents to the mobile communication terminal which moves in a wide area, and a mobile communication method and a mobile communication program used in the mobile communication system.” However, there is no such teaching in Yamaguchi that the isolated feature of column 8, lines 60-65, of Yamaguchi would only provide the object of Yamaguchi's invention as disclosed in column 1, lines 10-15. Thus, the suggested motivation has no basis in the references or any other reasoned ground and thus the combination is improper.

In addition, the system architectures of Fenton and Yamaguchi are different (*see e.g.* Figures 1 of both Fenton and Yamaguchi) whereby it is not clear how the suggested combination should or could be carried out. As a result, the present invention as claimed

in independent claims 1, 19, 45, 60, 65, 66 and 70 is patentable over Fenton in view of Yamaguchi.

The above distinctions were discussed during an interview conducted between the Examiner and Applicants' representative by telephone on February 24, 2009. Although the Examiner appeared to be persuaded by the distinctions noted above, the Examiner expressed concern that the same deficiencies identified with respect to claim 1 might not apply to the other independent claims, since (in the Examiner's position) the distinction between the two system entities may not be reflected in the other independent claims. Applicants respectfully disagree.

Similar features may be found in each of the independent claims:

Independent claims 65 and 66 are respective method and means-plus-function claims that have similar scope to independent claim 1. Although the other claims are specifically directed to an apparatus or a method that can be accomplished by a single apparatus, the claims recite corresponding features.

Independent claim 19 recites a method performed by a device that provides a value-added service and that interacts with a network entity providing a multimedia messaging service. Independent claim 60 recites a computer-readable storage medium including a computer program set, wherein the execution of the program set in a computer causes the computer to execute a method that is similar to the method of claim 19. Likewise, independent claim 45 recites an apparatus that is configured to provide a value-added service and this is configured to interact with a network entity that provides

a multimedia messaging service. Finally, apparatus claim 70 is a means-plus-function claim that is similar in its scope to claim 60 and/or 19.

Thus, it is respectfully submitted that distinctions above also serve to distinguish each of the pending independent claims from the combination of Fenton and Yamaguchi. It is, therefore, respectfully requested that the rejection of claims 1, 19, 45, 60, 65, 66 and 70 be withdrawn for at least the reasons identified above.

Claims 2, 5-9, 11-18, 20, 23-27, 29-34, 36, 46, 49-53, 55-59, and 61-64 depend respectively from, and further limit, claims 1, 19, and 45. Thus, each of claims 2, 5-9, 11-18, 20, 23-27, 29-34, 36, 46, 49-53, 55-59, and 61-64 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that the rejection of claims 2, 5-9, 11-18, 20, 23-27, 29-34, 36, 46, 49-53, 55-59, and 61-64 be withdrawn.

The Office Action rejected claims 3, 10, 21, 28, 47, and 54 under 35 U.S.C. §103(a) as being allegedly unpatentable as obvious over Fenton in view of Yamaguchi, and further in view of U.S. Patent No. 6,917,813 of Elizondo (“Elizondo”). The Office Action acknowledged that combination of Fenton and Yamaguchi does not disclose or suggest the additional features of the rejected claims and cited Elizondo to remedy such deficiencies. Applicants respectfully traverse this rejection.

Claims 3, 10, 21, 28, 47, and 54 depend respectively from, and further limit, claims 1, 19, and 45. At least some of the deficiencies of the combination of Fenton and Yamaguchi with respect to claims 1, 19, and 45 are discussed above. Elizondo does not

remedy such deficiencies of the combination of Fenton and Yamaguchi, and consequently the combination of Fenton, Yamaguchi, and Elizondo does not disclose or suggest all of the elements of any of the presently pending claims.

Elizondo generally relates to provision of short message services. As explained at column 2, lines 47-56, thereof, Elizondo aims to provide a method that allows the HLR to determine the proper address for the MSC (or VLR) serving a roaming MS, when requested by an external node, while enabling communication between the external node and the MS, MSC, or VLR, so as to provide proper addressing of SMS services to MSs roaming in an SS7 network that is different from the MS home network, when SMS reception from SS7 networks is not being used by the MS. Accordingly, it is unsurprising that Elizondo fails to remedy the above-identified deficiencies of the combination of Fenton and Yamaguchi. Thus, it is respectfully requested that the rejection be withdrawn.

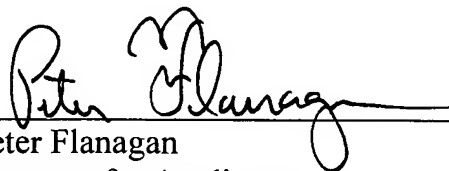
For the reasons set forth above, it is respectfully submitted that each of claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 recites subject matter that is neither disclosed nor suggested in the cited art. It is, therefore, respectfully requested that all of claims 1-3, 5-21, 23-34, 36, 45-47, 49-66, and 70 be allowed, and that this application be passed to issuance.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by

telephone, Applicants' undersigned representative at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,


Peter Flanagan
Attorney for Applicants
Registration No. 58,178

Customer No. 32294
SQUIRE, SANDERS & DEMPSEY LLP
14TH Floor
8000 Towers Crescent Drive
Vienna, Virginia 22182-6212
Telephone: 703-720-7800
Fax: 703-720-7802

PCF:dlh